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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,863	04/06/2001	Robert Lawrence Prorise	8037M	6081

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EXAMINER

PRATT, HELEN F

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 01/31/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,863

Applicant(s)

PROSISE ET AL.

Examiner

Helen F. Pratt

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-72 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 09/828,016 and claims 1-124 of 09/828,018, application 09/827,802 claims 1-20, application 09/827,436, claims 1-31 and 09/828,015, claims 1-18. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations in terms of amounts, water activities, and taste values of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1761

Claims 5, 17, 29, 41, 53 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5, 17, 29, 41, 5, 65 are indefinite in the use of the phrase "at least 75% active". It is not known what is intended by this phrase.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-16, 18-28, 30-40, 42-52, 54-64, 66-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (4,900,566) or Michnowski (4,859,475).

Howard discloses a confectionery product in the form of a bar, which can be a meal replacement. The bar contains 100% of the recommended daily allowance and fiber (col. 10, lines 65-68). At least 5 grams of an amino acid source is disclosed in the use of 5-18 grams of protein in the reference (col. 3, lines 50-51). Fat is disclosed in amounts of from 3 to 25 grams (col. 11, lines 45-55). Fiber can be in the amount of 0.4 to 5% as disclosed in WO 80/0226 as cited in col. 1, lines 63-70 and col. 2, lines 1-8 or it can be at least 15% (col. 5, lines 65) with the remaining amounts being carbohydrates. Michnowski discloses a high protein nutritionally balanced snack (abstract and col. 2, lines 54-65). Also, disclosed therein is a food bar containing 25%

Art Unit: 1761

proteins (col. 1, lines 31-40). The water activity (A_w) is seen to have been within the claimed value because there is no added water (ex. 1-2 of Michnowski). Of corn syrup contains water, but nothing is seen at this time that the composition does not have the claimed A_w . Claim 1 differs from the reference in the particular confidence level and taste value. However, Applicants have disclosed that it is known how to test for these values (IDF). It is not seen that the foods of the above references do not have these values. Attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a RTE product, properties such as nutrition, preservation and

Art Unit: 1761

shelf life are important. It appears that the precise ingredients as well as their proportions affect the nutrition, preservation and shelf life of the product, and thus are result effective variables, which one of ordinary skill in the art would routinely optimize. Therefore, it would have been obvious to make a product containing the claimed ingredients and other parameters and to tailor th product to achieve a particular confidence level.

Claims 2 and 3 further require less water activity and other ingredients (adjuncts) and particular amounts of amino acids and dietary fiber. The reference to Howard discloses the use of vitamins and minerals and other ingredients (adjuncts) (col. 8, lines 26-70). The further reduction of water activity is seen to have been within the skill of the ordinary worker as this involves the addition of ingredients, which makes water unavailable, or the use of less water in the composition. Fiber in amounts of from 0.4 to 5% of cellulose gum and gel are disclosed in col. 2, lines 1-7. In addition, nothing is seen that the cited compositions are not within the claimed values. Therefore, it would have been obvious to make products with varying ingredients and taste values as claimed because as in In re Levin, and in In re Boesch above, nothing new is seen in adding and subtracting ingredients, and in varying the amounts absent anything new or unobvious and nothing has been shown that the taste values are not present in the claimed composition.

Claim 4 requires that the foods are particular types of snack foods. However, as the references disclose the claimed ingredients to be in the form of bars, which is disclosed by Howard (col. 4, lines 28-35). Also, nothing new is seen in using the

Art Unit: 1761

claimed ingredients in other food forms, because generally many processed foods contain protein, fat and carbohydrates and some contain fiber as above, and it would have been obvious to vary the amounts of ingredients to fulfill particular nutritional goals as foods that are balanced nutritionally are known as above.

Claim 6 requires a particular amino acid score. As the availability of amino acids is well known, it would have been within the skill of the ordinary worker to choose types of protein containing such a particular score since proteins such as milk and eggs which are commonly used in foods are considered to have an amino acid level near 1 being complete proteins. Various types of proteins are disclosed by Michnowski (col. 5, lines 50-63). Therefore, it would have been obvious to use complete proteins or nearly complete proteins in a nutritional product in order to achieve a particular level of nutrition.

Claims 7-9 require particular types of fats and indigestible fats or digestible fats (lipids) in particular amounts. However, nothing new is seen in the use of the claimed fats which are used for their known function. The use of lesser fats is within the skill of the ordinary worker to vary (Boesch, *supra*). Therefore, it would have been obvious to use known fats in the composition of the references in particular amounts.

Claim 10 requires arabinogalactan fiber and beta-glucan soluble fiber, which are listed in the specification having known manufacturers. As the fibers are known, it would have been obvious to use them in place of the fibers of the references for their known function of providing bulk.

.Art Unit: 1761

Claim 11 requires particular vitamins and minerals. Howard discloses the use of all trace elements and vitamins required by man (col. 8, lines 6-25). The particular amounts are seen as being within the skill of the ordinary worker depending on the degree of fortification required particularly as the use of the Recommended Daily allowances of vitamins and minerals is a settled matter. Therefore, it would have been obvious to use known elements for their known functions in the claimed composition.

Claim 12 requires that the composition is in particular forms such as crackers and snacks. However, as the composition contains ingredient which are commonly in such types of foods, and Howard discloses his composition in the form of a bar, which is much like a brownie or the claimed bar, it would have been obvious to use known ingredients to make the various types of foods claimed.

Claim 13 requires particular confidence levels, and taste value of -9.00 . However, it would have been within the skill of the ordinary worker to make foods, that tasted like they were intended, hence the use of recipes, and the vast knowledge of how to make products taste good, i. e. with salt, sugar and flavors, etc. Therefore, it would have been obvious using the claimed composition to add other ingredients to a composition and to make it taste within a certain value system.

Claim 14 further requires that the food have an A_w of less than .85 and containing an adjunct ingredient. It is not seen at this time that the above references do not have the claimed A_w and they certainly contain other ingredients. Even so, it would have been within the skill of the ordinary worker to vary the water content of a food in

Art Unit: 1761

order to arrive at a particular Aw. Therefore, it would have been obvious to use particular water activities and adjunct ingredients.

The further limitations of claims 15-16, 18-28, 30-40, 42-52 and 54-64, 66-72 have been discussed above and are obvious for those reasons.

Claims 5, 17, 29, 41, 53, 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard or Michnowski as applied to claims 1-4, 6-16, 18-28, 29-40, 42-52, 54-64, 66-72 above, and further in view of Wong et al. (2002/0037355A1).

The above claims require that the fiber source is 75% active and can be a soluble fiber or insoluble fiber, with each type of fiber having particular characteristics. Wong et al. disclose a spread containing fiber. The fiber can be FIBERSOL (trademark) as disclosed in applicants' specification on page 21, lines 20-25). For soluble fiber a particular viscosity is claimed which is not cited in the reference. However, as it is known that fibers hydrate and can make a solution viscose according to the amount of fiber added to the solution, it would have been within the skill of the ordinary worker to use the appropriate amount of fiber for whatever viscosity was required for the product. It is noted that as in claim 4, various types of products are claimed, which would require various viscosities. Therefore, it would have been obvious to use a particular amount of fiber to make a particular viscosity in the claimed composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-

•Art Unit: 1761

1978. The examiner can normally be reached on Monday, Wednesday and Friday from 9:30 to 6:00 and Tues and Thurs. from 4:30 to 10 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 3959. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

Hp 1-23-03


HELEN PRATT
PRIMARY EXAMINER